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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,578	11/21/2003	Michael R. McGovern	87086CEB	3264

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EXAMINER

HUSON, MONICA ANNE

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/719,578	Applicant(s) MCGOVERN ET AL.	
	Examiner Monica A. Huson	Art Unit 1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to the Amendment filed 31 March 2006.

Due to applicant's amendment, the rejections of claims 3 and 4 under 35 USC 112 (2nd) have been overcome.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Although the specification contains information that identifies one static coefficient of friction as less than another (see specification, page 5, lines 13-16), the phrasing of the claim is not clearly supported by the subject matter in the above-cited portion of the specification.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Although the specification contains information that identifies one static coefficient of friction as less than another (see specification, page 5, lines 13-16), the phrasing of the

specification does not clearly support the subject matter of the amended claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Akao et al. (U.S. Patent 4,989,802), in view of Frazzitta et al. (U.S. Patent 6,472,028). Akao et al., hereafter "Akao," show that it is known to carry out a method of manufacturing a web-winding device (Abstract) comprising the step of providing a generally cylindrical injection molded support structure having an outer web wrapping surface for receiving at least one convolution of a web and, an interior portion having an annular surface joined to the outer web wrapping surface (Column 3, lines 22-38). Akao does not discuss the surface texture of the outer surface. Frazzitta et al., hereafter "Frazzitta," show that it is known to carry out a method for making a web-winding device wherein an outer web wrapping surface has a surface texture of less than 0.5 microns Ra (Column 8, lines 62-67; Column 9, lines 1-8; It is noted that although Frazzitta does not explicitly disclose relative static coefficients of frictions, that material property will be inherent to and dependent upon the surface texture of the wrapping surface. Therefore, it is being held that since Frazzitta suggests the claimed surface texture, the inherent static coefficients of frictions would also be achieved by his disclosure.). Frazzitta and Akao are combinable because they are concerned with a similar technical field, namely, web winding

devices. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to form Frazzitta's specific surface texture during Akao's molding process in order to mold a device which operates per customer specifications.

Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akao and Frazzitta, further in view of Schneider et al. (U.S. Patent 5,873,543).

Regarding Claim 2, Akao shows the process as claimed as discussed in the rejection of Claim 1 above, but he does not show specific materials for his device. Schneider et al., hereafter "Schneider," show that it is known to carry out a method wherein the step of providing a generally cylindrical injection molded support structure further comprises the step of providing said outer web wrapping surface with a material selected from the group consisting of modified amorphous thermoplastic resins and semi-crystalline thermoplastic resins (Column 4, lines 39-44). Schneider and Akao are combinable because they are concerned with a similar technical field, namely, methods of molding winding devices. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Schneider's material in Akao's molding process in order to produce an article that has the desired physical and chemical characteristics of the chosen materials.

Regarding Claim 3, Akao shows the process as claimed as discussed in the rejection of Claims 1 and 2 above, but he does not show specific materials for his device. Schneider shows that it is known to carry out a method wherein said step of providing said outer web wrapping surface further comprises the step of providing said modified amorphous thermoplastic resin selected from the group consisting of lubricated polycarbonate and silicone polycarbonate copolymers (Column 4, lines 44). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use

Schneider's material in Akao's molding process in order to produce an article that has the desired physical and chemical characteristics of the chosen materials.

Regarding Claim 4, Akao shows the process as claimed as discussed in the rejection of Claims 1 and 2 above, but he does not show specific materials for his device. Schneider shows that it is known to carry out a method wherein said step of providing said outer web wrapping surface further comprises the step of providing said semi-crystalline resin selected from the group including polybutylene terephthalate, polybutylene terephthalate/polycarbonate alloys and a modified polybutylene terephthalate (Column 4, lines 39-44). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Schneider's material in Akao's molding process in order to produce an article that has the desired physical and chemical characteristics of the chosen materials.

Regarding Claim 5, Akao shows the process as claimed as discussed in the rejection of Claims 1, 2, and 4 above, but he does not show using a filler. Schneider shows that it is known to carry out a method wherein the step of providing said modified polybutylene terephthalate includes the step of providing said modified polybutylene terephthalate with about 20 weight percent solid glass bead (Column 2, line 43; Column 4, lines 36-43). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Schneider's material in Akao's molding process in order to produce an article that has the desired physical and chemical characteristics of the chosen materials.

Response to Arguments

Applicant's arguments filed 31 March 2006 have been fully considered but they are not persuasive.

Applicant contends that Akao does not suggest the instant invention because he does not show a smooth texture of the winding core. This is not persuasive because a “smooth” surface is not explicitly claimed.

Applicant contends that Akao does not suggest the instant invention because his core does not rely on frictional attachment of the film to the core. This is not persuasive because this method of attachment is not explicitly claimed.

Applicant contends that Akao and Frizzitta do not suggest the instant invention because Frizzitta does not disclose a web winding device. This is not persuasive because Frizzitta was cited only to show a surface texture of a roll that is used in a winding process. It is maintained that Frizzitta shows a winding process, as element 21 is wound to some extent around the roll.

Applicant contends that Akao and Frizzitta do not suggest the instant invention because Akao would teach away from surface modification as a film slot is present. This is not persuasive because it is not clearly evident that having surface modification and a film slot are necessarily mutually exclusive. Therefore, it is believed that Akao could feasibly appreciate the benefits of certain surface textures while still using his film slot.

Applicant contends that Schneider, Akao, and Frizzitta do not suggest the instant invention because Schneider is concerned with a hub that has elastomeric ribs between the concentric hubs. This is not persuasive because such a configuration is not excluded by the present claim language. It is maintained that since Schneider teaches a winding process, his disclosure is easily and feasibly combinable with Akao to show the limitations of claims 2-5.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica A. Huson whose telephone number is 571-272-1198. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1732

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Monica A Huson

June 13, 2006


CHRISTINA JOHNSON
PRIMARY EXAMINER

6/15/06